

REMARKS

Applicants and the undersigned reviewed this Office Action carefully before preparing this response. Reconsideration is respectfully requested. Nonetheless, in light of the positions presented herein, this application is believed to be in condition for allowance.

Several claims were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for use of the term "substantially". Applicants appreciate the Examiner's concern, but respectfully disagree. The Federal Circuit has consistently found "substantially", as used with another claim term, not indefinite. It is well established that "substantially" is not indefinite when it serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art. See, *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002).

As presently used, "substantially" can be understood with reference to the prior art. For instance, an amorphous film is understood by those in the art as a film which may provide a more desirable seal to avoid access of corrosive gas or liquids to a substrate, as compared to crystalline coating not providing such protection, because of grain boundaries and other defects. (See, e.g., specification page 3 at lines 21-25.) Likewise, a non-porous film can be distinguished from a porous catalytic material or prior art approach which would leave a film porous or cracked. (See, e.g., specification pages 3 at lines 1-9 and 22 at lines 7-13.)

The American Heritage Dictionary, Second College Edition, 1213 (2nd Ed. 1982) defines substantially as "considerable in . . . extent". See, *Ecolab, Inv. v. Envirochem, Inc.*, 264 F3d 1358, 1366, 60 USPQ 2d 1173 (Fed. Cir. 2001). As would be understood by those skilled in the art, a "substantially amorphous" film can be considerably amorphous to the extent it can provide a hermetic-quality seal, as compared to a

crystalline film. Likewise, a "substantially non-porous" film can be considerably non-porous, as compared to a porous catalyst or a porous/cracked film of the prior art. As such, the term "substantially" is not indefinite, but rather readily understood by those skilled in the art in the context of the present invention. Accordingly, this rejection should be withdrawn, with the subject claims allowed to proceed toward issue.

Several claims were rejected under 35 U.S.C. § 103, as being unpatentable over Colebourne. Again, Applicants appreciate the Examiner's concern, but respectfully disagree. Colebourne does not establish *prima facie* obviousness.

Most notably and without limitation, Colebourne does not describe an aluminophosphate material. The metal component(s) of the Colebourne material are expressly limited to those of atomic number recited in col. 1 at lns. 18-21. As the atomic number of aluminum is 13, Colebourne teaches away from an aluminophosphate film. That is, Colebourne would direct one skilled in the art away from doing what Applicants have done. Such a misdirection does not establish obviousness.

Further, § 103 requires that obviousness be determined on the basis of the claimed "subject matter as a whole". In this case, the Examiner did not properly consider the terms "substantially amorphous" and "substantially non-porous". The Colebourne films are not of aluminophosphate, and such terms cannot be assumed. More specifically with regard to independent claim 1, absent an aluminophosphate film, there can be no summary conclusion about the presence of a component between the film and substrate. Colebourne does not describe such terms, and Tunker fails to address the deficiency. Without a determination on the entire claimed subject matter, there is no obviousness.

Colebourne, alone or in combination with Tunker, fails to establish *prima facie* obviousness. A plain-reading of Colebourne directs one away from Applicants' invention. The rejection should be withdrawn, with the subject claims allowed to proceed toward issue.

This application is believed to be in condition for allowance. Consistent therewith, favorable action is respectfully requested. The Examiner is invited to contact the undersigned by telephone should any issue remain. Thank you for your time and consideration.

Respectfully submitted:



Rodney D. DeKruif
Attorney for Applicants
Registration No. 35,853

Reinhart Boerner Van Deuren s.c.

1000 North Water Street, Suite 2100
Milwaukee, WI 53202
(414) 298-8360
Customer No. 22922